

**REMARKS**

The last Office Action has been carefully considered.

It is noted that claims 1 and 2 are rejected under 35 U.S.C. 102(b) over the patent to Bruno.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) over the patent to Hayden or Lundberg.

Claim 9 is rejected under 35 U.S.C. 103(a) over the patent to Bruno in view of the patents to Hayden or Lundberg and further in view of the patent to Turner.

The claims are also rejected for formal reasons under 35 U.S.C. 112.

At the same time the Examiner indicated that claims 11-16 appeared to be allowable over the prior art of record.

The Examiner's indication of the allowability of claims 11-15 has been gratefully acknowledged. In connection with this indication, these claims have been retained as they were.

After carefully considering the Examiner's grounds for the rejection of the claims as well as the issues raised by the Examiner in the Advisory Action, applicant has amended claim 1 further.

With the Amendment to claim 1 applicants first of all removed the last two lines which were objected by the Examiner and constituted the reason why the Request for Reconsideration was not entered. At the same time, the features claims 2 and 9 have been introduced into claim 1.

It is respectfully submitted that claim 2 was dependent on claim 1 and claim 9 was dependent on claim 2, and therefore the introduction of the features of claims 2 and 9, which have been canceled does not raise any new issues for examination and/or search after the Final Action, since claims 1, claim 2 which was dependent on claim 1, and claim 9 which was dependent on claim 2 directly and on claim 1 indirectly, were examined by the Examiner before the Final Office Action.

It is respectfully submitted that the new features of the present invention which are now defined in the amended claim 1 are not disclosed in the references; and could not be derived from it as a matter of obviousness.

Before the analysis of the prior art, it is believed to be advisable to analyze claim 1 and explain its features in detail.

Claim 1 defines a saw blade for power tools, which comprises the following elements:

a blade back (11) and a tothing (12),

said tothing extending along a lower edge of the blade back (11) and including many saw teeth lined up in succession,

wherein in successive portions (a, b) of the tothing (12), each with an integral number of saw teeth (13), the saw teeth (13) have the same tooth width ( $a_z$ ,  $b_z$ ), as measured at a top-cutting edge in a direction of a thickness of the saw blade, wherein said same tooth width ( $a_z$ ) is different from the saw teeth (13) in the preceding or succeeding portion (a) of the tothing (12),

wherein a first tooth width ( $a_z$ ) of the saw teeth (13) in one set of portions (a) of the tothing (12) is equivalent to a thickness of the blade

back (11), and a second tooth width ( $b_z$ ) of the saw teeth in the other portions (b) of the toothing (12) differing from the first tooth width ( $a_z$ ) is achieved by a material removal or material compacting, and

wherein successive portions (a, b) of the toothing (12) have in alternation one tooth of large tooth width ( $a_z$ ) and two teeth of reduced tooth width ( $b_z$ ).

Claim 1 in addition to other features, now defines that the tooth width  $A_z$  of the saw teeth 13 in one set of portions a of the toothing 13 is a equivalent to a thickness of the blade back 11. With this feature, a cost-favorable minimal machining of the saw blade workpiece is possible, with which the flat sides over the whole width to the tooth tips extend parallel to one another and can stay without machining, and the machining can be performed only in portions and only the toothing must be machined by regular limited material removal or material compacting in the width and depth of second teeth. The toothing pattern which includes, as now defined in claim 1, the successive portions a, b of the toothing having in alternation one tooth of large tooth width  $a_z$  and two teeth of reduced tooth width  $b_z$ , provides a saw blade that is especially steadily and reliably centered in the cutting passage, is robust and maintains its sharpness for a long time period. Its orderly tooth sequence is composed of five teeth of two identical smaller saw teeth that are ground from one side, a thicker following tooth, and again

two identical smaller teeth that are ground from the opposite side, and which correspondingly determines the width of the cutting passage and thereby the quality of its flanks, or in other words the visible sides in any cutting depth.

In contrast, in the saw blades disclosed in the references, the thickness of the blade back 11 is either smaller or greater than the thickness of the tooth back, and not, as in the saw blade in accordance with the present invention has the same thickness. This difference is very significant. The difference related to with the toothed thickness and the thickness of the blade back is connected with high machining expenses. When the blade back is less thick than the thickest tooth, then the material removal is required over the whole length of the blade back. When however all teeth are less thick than the blade back, a material removal on all tooth flanks is needed.

None of the references teaches the above mentioned new features of the present invention. The patent to Bruno taken singly does not teach these features. As for the Examiner's rejection of the original claims over the patent to Bruno, it is believed to be advisable to cite the decision in *re Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984) in which it was stated:

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim."

Definitely, the patent to Bruno does not disclose each and every feature of the saw blade as defined now in the amended claim 1, and therefore the anticipation rejection should be considered as no longer tenable and should be withdrawn.

The patents to Hayden, Lundberg and Turner also do not teach these new features of the present invention. Therefore, any combination of the references would lead to a saw blade which would not include the above mentioned new features of the present invention. In order to arrive at the applicant's invention from the combination of the references, it would not be sufficient to simply combine them, but instead they have to be fundamentally modified by including into it them the new features of the present invention as specified herein above. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision in re Randol and Redford (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest: it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Also, as explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references. It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments it is believed that claim 1, the broadest claim on file, should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to Issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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